

TELEPHONE (312) 258-5500



SCHIFF, HARDIN LLP

PATENT DEPARTMENT

6600 SEARS TOWER

233 SOUTH WACKER DRIVE

CHICAGO, ILLINOIS 60606

CONFIRMATION NO.: 3683

IN RE APPLICATION OF: Johansson et al.

SERIAL NO.: 10/659,859

GROUP ART UNIT: 3683

FILED: September 11, 2003

EXAMINER: Douglas C. Butler

TITLE: "ELECTROMAGNETIC BRAKE ASSEMBLY AND POWER SUPPLY
RESPONSE TO THE APRIL 8, 2005 OFFICE ACTION

MAIL STOP AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

SIR:

Transmitted herewith is an amendment in the above-identified application.

☐ No additional fee is required.

The fee has been calculated as shown below.

CLAIMS AS AMENDED						
	(2) CLAIMS REMAINING AFTER AMENDMENT		(4) HIGHEST NO. PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEE
TOTAL CLAIMS	*9	MINUS	**20	X	() X 25.00 () X 50.00	
INDEP. CLAIMS	*3	MINUS	3	X	() X 100.00 () X 200.00	
Application amended to contain any multiple dependent claims not previously paid for.				() YES () NO	() \$180.00 () \$360.00 ONE TIME	
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$0.00

* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20 write "20" in this space.

- ☐ Applicants petition the Commissioner of Patents and Trademarks to extend this time for response to the Office Action dated _____ for _____ months so that the period for response is extended to _____. A check in the amount of \$_____ is attached to cover the cost of the extension. Any deficiency or overpayment should be charged or credited to deposit account No. 501519. A duplicate copy of this sheet is enclosed.
- ☐ A check in the amount of \$_____ is attached.
- ☐ A check for \$_____ accompanying IDS under 37 CFR 1.97(c) is attached
- ☐ A check for \$_____ and Petition for Consideration of IDS under 37 CFR 1.97(d) is attached.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to account No. 501519. A duplicate of this sheet is enclosed.
- When phoning re this application, please call (312) 258-5500.

SCHIFF, HARDIN LLP (Customer Number: 26574)

Patent Department

BY Steven H. Noll (28,982)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on April 21, 2005

Steven H. Noll

NAME OF APPLICANT'S ATTORNEY

Steven H. Noll

SIGNATURE

April 21, 2005

DATE



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RESPONSE TO THE APRIL 8, 2005 OFFICE ACTION

APPLICANTS: Johansson et al. CONFIRMATION NO.: 3683
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S I R:

In the April 8, 2005 Office Action, the Examiner repeated the previously-imposed election of species requirement between, according to the Examiner, the species of Figure 1 and the species of Figure 2. Election of a single disclosed species was required under 35 U.S.C. §121. The Examiner stated that none of the claims appears to be generic.

In Applicants' previous response, Applicants questioned the Examiner's authority to simultaneously render an action on the merits and to impose an election of species requirement. As noted by the Applicants in their previous response, an election of species is for the purpose of relieving the Examiner from having to search prior art directed to the non-elected species, if there is no allowable generic claim. As noted in Applicant's previous response, since the Examiner has already conducted searching of the prior art, and rendered a rejection based on the prior art, the reason for making an election of species requirement is moot. Applicants therefore requested the Examiner's authority for simultaneously rendering an action on the merits and imposing an election of species requirement.

In response, the Examiner cited MPEP §811.02, which in turn states that 37 C.F.R. §1.142(a) provides that restriction is proper at any stage of prosecution up to a final action. Applicants of course are aware of this language in 37 C.F.R. §1.142(a), however, this language does not address Applicants' assertion that the Examiner has no statutory authority to *simultaneously* render an action on the merits and to impose an election of species requirement. The cited language in 37 C.F.R. §1.142(a) recognizes that an Examiner may not immediately appreciate the need for an election of species requirement until a stage in the prosecution after a first Office Action has been rendered. This situation is recognized in the language of MPEP §811, which states that if the election of species requirement is not made in a first Office Action, it should be made "as soon as the need for a proper requirement develops."

If an action on the merits is rendered simultaneously with an election of species requirement, this does not satisfy the language of MPEP §811, because in such a situation, when the Examiner renders the action on the merits, the Examiner already knows that the need for a proper requirement has developed. Moreover, MPEP §811 explicitly states that before making a restriction requirement after the first action on the merits, the Examiner will consider whether there will be a serious burden if restriction is not required. By rendering an action on the merits simultaneously with an election of species requirement, the Examiner has no opportunity to consider whether there will be a serious burden, because the Examiner at that time does not know what the Applicants' response to the action on the merits will be.

The difficulties imposed by this situation are exacerbated by the latest Office Action from the Examiner, which makes no indication whatsoever as to whether Applicants' arguments traversing the rejections on the merits have been accepted.

This situation is made more difficult by the Examiner simply stating that the application contains two species, namely the species of Figure 1 and Figure 2, but providing no detailed explanation as to why the Examiner believes these two species are patentably distinct. Figure 1 discloses a generic alternating current source 24 in the power supply 16, and the embodiment of Figure 2 simply uses a capacitor 40 as this alternating current source. This is why, in Applicants' previous response, claim 1 was submitted to be a generic claim on which all claims are readable. In order for claims 7 and 8, which specifically claim the use of a capacitor, not to be considered as falling within the generic scope of claim 1, the Examiner would have to consider a capacitor not to be one form of an alternating current source, which is obviously not technically correct. In stating that Figures 1 and 2 are directed to patentably distinct species, does the Examiner contend that if the species of Figure 1 is elected, the Examiner would not have to search in prior art classification wherein a capacitor is used as an alternating current source? Since the Examiner already has apparently conducted searching wherein the Examiner has, in fact, included prior art searching relating to claims 7 and 8, the Examiner's reason, without the Examiner providing any further explanation, for again imposing the restriction requirement is even less understood.

In order to provide a complete response Applicants again, as in their previous response, elect the species of Figure 1, and for the reasons noted above submit that all claims are readable on that species. Moreover, Applicants submit that claim 1 is

a generic claim which, if allowable over the prior art would require withdrawal of the election of species requirement. This is why it is a further unfair imposition on the Applicants to again impose this restriction requirement, since Applicants have already submitted arguments traversing the Examiner's rejection of independent claim 1, but the Examiner has not commented on those arguments. In view of those arguments, it is Applicants' belief that claim 1 is an allowable generic claim. By not commenting on the very arguments that the Examiner required the Applicants to submit, by simultaneously rendering an action on the merits and an election of species requirement, the Examiner has placed the Applicants in an even more difficult position.

If the Examiner disagrees with Applicants statements concerning the claims readable on the elected species, the allowability of generic independent claim 1, or the Examiner's statutory authority to continue to impose an election of species requirement, the Examiner is respectfully requested to provide more explanation to the Applicants than was provided in the last Office Action, so that Applicants at least can make informed decisions.

Submitted by,

 (Reg. 28,982)

SCHIFF, HARDIN LLP, **CUSTOMER NO. 26574**
Patent Department, 6600 Sears Tower
233 South Wacker Drive, Chicago, Illinois 60606
Telephone: 312/258-5790
Attorneys for Applicants

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